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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,925	09/30/2003	Avi Zahavi	1756	7371

7590 03/08/2005

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EXAMINER

MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/673,925		ZAHAVI, AVI	
	Examiner		Art Unit	
	Thomas A. Morrison		3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/24/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, the specification fails to describe the recited surface contact portion. The specification also fails to clearly point out which disclosed element constitutes the surface contact portion.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1 and 3 and their dependent claims 2 and 4, there is insufficient structural relationship recited between the clamping portion, the roller and the elevating means in claims 1 and 3, to understand how the clamping portion is

positioned at a given distance from the roller when the roller and the surface-contact portion are in contact with the surface of the slip-sheet, and the clamping portion is in contact with the roller when the roller and the surface-contact portion are not in contact with the surface of the slip-sheet, as claimed.

For claims 1 and 3, it is also unclear when the clamping portion is in contact with the roller. More specifically, Figs. 1-3 show that either (1) the clamping portion is not in contact with the roller (bottom of Fig. 1) or (2) the slip sheet is captured between the clamping portion and the roller (i.e., the sheet separates the clamping portion from the roller). In fact, the claimed contact between the clamping portion and the roller appears to be inaccurate. Rather, page 10, lines 11-15 of the instant application appears to disclose that the paper is clamped between the clamping portions 45 and the roller 20 when the knees 35 of clamps 30 are detached from the paper.

Regarding claims 1 and 3, the word "means" is preceded by the word(s) "rotating" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Glassby. In particular, Glassby discloses all of the limitations of claim 1.

Regarding claim 1, Figs. 1-3 show a slip-sheet picking and discarding mechanism including

a roller (8) having a longitudinal dimension (Fig. 2) spanning the width of the slip-sheet (13);

rotating means (including 9, 6 and 7) connected with the roller (8).

at least one clamping means (including 3) arranged along the longitudinal dimension of the roller (8), each at least one clamping means (3) having a clamping portion (3' in Fig. 1) and a surface-contact portion (bottom surface of 3); and

elevating means (column 3, lines 6-13 and Fig. 3) for elevating the roller (8) and the at least one clamping means (including 3), wherein the clamping portion (3' in Fig. 1) is positioned at a given distance from the roller (8) when the roller (8) and the surface-contact portion (bottom surface of 3) are in contact with the surface of the slip-sheet (13) (Fig. 1 shows the given distance of the clamping portion from the roller), and

wherein the clamping portion (3' in Fig. 1) is in contact with the roller (8) when the roller and the surface-contact portion (3') are not in contact with the surface of the slip-sheet (13). Regarding the recited rotating means, the arrangement of elements 6, 7 and 9 causes the roller (8) to rotate when the roller (8) is lowered onto slip sheet (13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Glassby as applied to claim 1 above, and further in view of Larsen et al. In particular, Glassby in view of Larsen et al. meets all of the limitations of claim 2. Glassby discloses all of the limitations of claim 2, except for the disposal means for disposing the slip-sheet.


Larsen et al. discloses that it is well known to provide a slip-sheet picking and discarding mechanism (100) with disposal means (including 160, 162 and 164) for disposing slip sheets (28). Larsen et al. explains that the drive rollers (160, 162) rotate in opposite directions to pull the slip sheet 28 downward into a bin for collection. See Fig. 13 and column 6, lines 38-45. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to provide the Glassby slip-sheet picking and discarding mechanism with disposal means in order to easily collect the slip sheets, as taught by Larsen et al.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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